

## REMARKS

Claims 8-9 and 11-14 were rejected. Claims 8-9 and 11-14 are amended. No new matter is presented. Claims 8-9 and 11-14 are now pending. The above amendments and the following remarks are considered by Applicants to overcome each rejection raised by the Examiner and to place the application in condition for allowance.

### *Rejection pursuant to 35 U.S.C. § 112*

The Examiner rejected claim 8 pursuant to 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants have amended claim 8 to remove the term “such as.” Accordingly, Applicants respectfully request withdrawal of the rejection.

### *Rejections pursuant to 35 U.S.C. § 103*

Claims 8-9 and 11-14 are rejected over a primary reference, Mecklenborg et al., either alone or in combination with other references. All of the rejections are under 35 U.S.C. § 103(a). Reconsideration and withdrawal of these rejections is respectfully requested in view of the following discussion.

Applicants have amended independent claim 8 to claim “A fundus camera” comprising the previously discussed optical system. As discussed in previous communications, Mecklenborg does not disclose a fundus camera for photographing the fundus of the eye, but a Scheimpflug visual probe. Such a probe differs substantially from that which is required in an optical fundus camera, and therefore Mecklenborg’s optical system is nonanalogous art unavailable in an obviousness rejection.

It may be argued that the “fundus camera” language is located in the preamble of claim 8, and therefore does not limit the claims. However, “[t]he determination of whether a preamble

limits a claim is made on a case-by-case basis in light of the facts in each case ...." *MPEP* 2111.02. "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Id.* (citing *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999)). The case of *Kropa v. Robie*, 187 F.2d 150, 88 USPQ 478, 481 (CCPA 1951) is illustrative:

A preamble reciting "An abrasive article" was deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. The court stated "it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable inter alia of use as abrasive grains and a binder is not an 'abrasive article.'" Therefore, the preamble served to further define the structure of the article produced.

*MPEP* 2111.02 (citing *Kropa*, 187 F.2d at 152).

Here, the term "fundus camera" is necessary to give life, meaning, and vitality to the claim. Only by that phrase can it be known that the subject matter defined by the claims is comprised as a fundus camera. Thus, the phrase is a material limitation. As discussed above, this material limitation is not disclosed by Mecklenborg, and Mecklenborg's Scheimpflug visual probe cannot render the fundus camera of claim 8 obvious.

Claim 8 further requires that "the optical axis of the illumination beam path and imaging beam path penetrates the lens outside their optical axes." The Examiner contends that Figure 7, references B and C or D and E, disclose this limitation. But Figure 7 and its discussion do not suggest or disclose the penetration of the lens outside their optical axes. Further, it would not have been obvious to add this feature to the invention, and the Examiner does not provide an

argument to the contrary. Further, the other references cited by the Examiner do not cure the deficiencies of Mecklenborg.

For these reasons, Applicants respectfully submit that it would not have been obvious to arrive at the invention of independent claim 8. Accordingly, Applicants respectfully request withdrawal of the obviousness rejections of independent claim 8 and dependent claim 9 and 11-14.

In addition, dependent claim 9 is further distinguishable from Mecklenborg because Mecklenborg does not disclose that “the first plane and the second plane extend substantially perpendicular to one another.” In Mecklenborg’s Scheimpflug probe, relay lens B and relay lens C are lying on one plane only. (*See* Mecklenborg, column 7:5-8.) If one relay lens is tilted and the second relay lens is tilted in the opposite direction, then both of them are lying in the same plane. Thus, Mecklenborg does not disclose the feature of dependent claim 9, and therefore claim 9 is further distinguishable from Mecklenborg.

An early action on the merits of these claims is respectfully requested.

Respectfully submitted,

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